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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/048,040	01/24/2002	Wolter Ten Hoeve	NL 010357	1130

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EXAMINER

TESKIN, FRED M

ART UNIT PAPER NUMBER

1713

DATE MAILED: 05/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/048,040

Applicant(s)

TEN HOEVE ET AL.

Examiner

Fred M. Teskin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-14 is/are pending in the application.
- 4a) Of the above claim(s) 4,5 and 9-14 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3 is/are allowed.
- 6) ☒ Claim(s) 6 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 032405.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

The reply of March 24, 2005, has been entered in full. Claims 1-6 and 8-14 remain pending herein.

Claims 4-5 and 9-14 stand withdrawn from further consideration as per 37 CFR 1.142(b), as being drawn to nonelected species and a nonelected invention, respectively. Applicant timely traversed the restriction requirement in the reply of October 20, 2003.

Upon reconsideration, it is determined that claim 6 was erroneously withdrawn from consideration in the prior Office action, as this claim is drawn to a subcombination of the combination (of polymers) claimed in claim 8, and the combination is not distinct from the subcombination. Accordingly, claim 6 is herewith rejoined with the claims to the elected invention, i.e., claims 1-3 and 8.

Claim 8 stands rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 remains indefinite due to improper Markush language in the recitation "chosen from the group *comprising* ..." (see, definition of variables R₁ and R₂) as detailed on page 3 of the previous Office action. The amended version of claim 8 fails to correct the improper use of open language in this Markush grouping; therefore, the rejection must be maintained.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 4900782 to Han et al.

Claim 6 is drawn to polymers with structural units having the defined formula (III).

Han et al differ from claim 6 only in that polymer having the SR_1 leaving group of formula (III) is not shown in a single embodiment.

However, Han et al identify species of the SR_1 moiety, among other moieties, as suitable examples of leaving group D in polymer formulae which otherwise correspond to claim formula (III). See column 3, formulae III – VI and lines 65-68 as well as column 7, lines 6-12 where D is defined as inclusive of moieties of formula $-SR_1$ where R_1 can be, e.g., alkyl (methyl, ethyl and the like); and claim 19 wherein $-SR_1$ is named as one of but five possible choices for D. Further, formulae III - VI include recurring units with five-membered rings that correspond to "Ar" in claim formula (III) - i.e., the rings each contain 4 carbon atoms and a heteroatom such as S, O or N (per the definitions of X_1 and X_2 at col. 4, lines 40-42 and claim 1 of Han et al) .

Based on the patentees' teachings and expressed preferences, it is concluded that one of ordinary skill in the art would have been inclined to select $-SR_1$ as the leaving group D in any of the disclosed formula III – VI to obtain polymers

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corresponding to applicant's formula (III) as claimed. One would have been so motivated by a reasonable expectation of obtaining another precursor polymer utile in the applications contemplated by Han et al (e.g., forming conducting articles and coatings; see col. 1, lines 11-15).

Accordingly, the subject matter of claim 6 is deemed to have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made.

Claims 1-3 are allowable. Claim 8 would be allowable if amended or rewritten to overcome the rejection under 35 USC 112 set forth in this Office action.

The following is a statement of reasons for the indication of allowable subject matter: The claimed method for preparing a polymer which comprises structural units of formula (I) starting with a compound having the formula (II) as per claim 1, is not disclosed nor fairly suggested in any prior art documents located or identified by the examiner as of the date of this Office action; nor is a composition of polymers with structural units having the formula (IX) and "first" and "second" fractions as defined in claim 8.

As the examiner's reliance on Han et al in rejecting claim 6 was not necessitated by amendment, this action is made non-final.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner F. M. Teskin whose telephone number is (571) 272-1116. The examiner can normally be reached on Monday through Thursday from 7:00 AM - 4:30 PM, and can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on (571) 272-1114. The appropriate fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FMTeskin/05-11-05


FRED TESKIN
PRIMARY EXAMINER
1713